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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,477	02/26/2002	Jeffrey A. Colborn	04813.0031.NPUS00	4887
27240	7590	04/22/2004	EXAMINER	
HOWREY SIMON ARNOLD & WHITE, LLP - OC			YUAN, DAH WEI D	
301 RAVENSWOOD AVENUE			ART UNIT	
BOX 34			PAPER NUMBER	
MENLO PARK, CA 94025			1745	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,477

Applicant(s)

COLBORN, JEFFREY A.

Examiner

Dah-Wei D. Yuan

Art Unit

1745

ed

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

METHOD OF AND SYSTEM FOR COOLING A BACKUP POWER SYSTEM

Examiner: Yuan

S.N. 10/085,477

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April 15, 2004

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 17-22, in Paper filed on April 4, 2004 is acknowledged. The traversal is on the ground(s) that the operation of the backup power system recited in Group III without the cooling system would be impractical. The independent claim 27 recites a backup power system comprising an electrochemical power system and a flow path for transferring fluid. The intended use "for powering a cooling system upon or after the occurrence of a power outage or reduction condition" in the claim does not add structure to the claim. Intended use of a known compound (system) does not give it patentable weight. See *In re Thuau*, 57 USPQ 324, CCPA 979 135 F2d 344, 1943. It is evident that the backup power system is a stand-alone system that does not need a cooling system. Applicant also contends that two distinct cooling systems recited in claims 1-16,23-26 and claim 30, respectively, are merely different embodiments of the same invention. Applicant does not submit evidence or identify such evidence showing the species to be obvious variants or clearly admit on the record that this is the case. Therefore, Invention I-1 (claims 1-16,23-26) and I-2 (claim 30) are considered as patentably distinct species as admitted in the statement above from the Applicant. Claim 1-16,23-30 are withdrawn from further consideration by the examiner per 37 CFR 1.142(b), as being drawn to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 17,20,21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-43 of copending Application No. 09/930,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the process of cooling a backup power system that powers a cooling system.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yang (US 6,692,852 B2) teaches a generating system for a fuel cell, and heat waste recirculation and cooling system of said generating system. Imazeki et al. (US 6,673,482 B2) teach a cooling system for a fuel cell includes a heat exchanger for cooling coolant discharged from the fuel cell and a heat regulator for adjusting a temperature of coolant to be supplied to the fuel cell.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dah-Wei D. Yuan whose telephone number is (571) 272-1295. The examiner can normally be reached on Monday-Friday (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

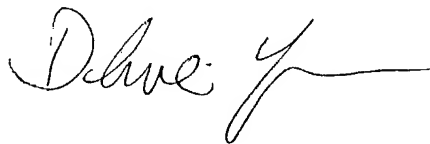
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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dah-Wei D. Yuan
April 15, 2004

A handwritten signature in cursive script, appearing to read "Dave Y", followed by a long horizontal flourish.